

II. REMARKS

A. Front Page of Office Action

The cover page of the January 21, 2003 office action indicates that claims 32-58 are pending in the application and that claims 32-58 are rejected.

In reply, the applicants agree that the front page summary of the office action reflects the contents of the office action.

B. Support for Amended Claims

Support for amended claim 50 is found on page 21 lines 1-3 of the specification.

Support for amended claim 58 is found on page 21 lines 4-8 of the specification. *110: I think this does not ID contain by their email address*

Support for newly added claims 59 and 76 is found on page 14 lines 13-20 of the specification.

Support for newly added claims 60 and 77 is found on page 12 line 21 of the specification.

Support for newly added claims 61 and 78 is found on page 21 lines 27-29 of the specification.

Support for newly added claims 62 and 79 is found on page 19 lines 25-26 of the specification.

Support for newly added claims 63 and 80 is found on page 21 lines 8-10 of the specification.

Support for newly added claims 64 and 81 is found on page 15 lines 18-20 of the specification.

Support for newly added claims 65 and 82 is found on page 12 line 22 and page 12 line 25 of the specification.

Support for newly added claim 66 is found on page 23 lines 9-10 of the specification.

Support for newly added claims 67 and 83 is found on page 28 lines 28-30 of the specification.

Support for newly added claims 68 and 84 is found on page 6 lines 17-22 and page 23 lines 8-9 of the specification.

Support for newly added claims 69 and 85 is found on pag 14 line 27 - page 15 line 1 and page 19 lines 22-23 of the specification.

Support for newly added claims 70 and 86 is found on page 14 line 27 - page 15 line 1 of the specification.

Support for newly added claims 71 and 87 is found on page 21 lines 14-15 of the specification.

Support for newly added claims 72 and 88 is found on page 21 lines 14-15 of the specification.

Support for newly added claims 73 and 89 is found on page 21 lines 8-9 of the specification.

Support for newly added claims 74 and 90 is found on page 24 lines 21-24 of the specification.

Support for newly added claims 75 and 91 is found on page 24 lines 9-12 of the specification.

C. Summary and Response to Items Enumerated in the Office Action

1. Item 1 - Objection to Cited Prior Art

In item 1, the examiner objects to the “tremendous volume of references.” The examiner states that:

Applicants have submitted more than 300 references which confuses the issue of patentability over the prior art. Examiner considers relevant information as to the patentability of the claimed invention may be buried under the thousands of pages of prior art references submitted by the applicants before a prior art search can be performed conducted [sic] by the Office. Applicants have not offered assistance to the Office by explaining the patentability of the claimed invention in light of the tremendous volume of references. It is requested that the applicant highlight the most relevant references for the Office per MPEP 2004. [Office Action mailed 1/21/03 page 2 lines 3 - 10.]

In reply, applicants do not know of any references more relevant than those already cited by the examiner in this or the related cases. Applicants do regret the volume of prior art forced into this application.

2. Item 2

In item 2, the examiner quotes 37 CFR 1.105.

3. Item 3 - 37 CFR 1.105 Requirement

In Item 3, the examiner requests prior art that is relevant in light of 37 CFR 1.105. The examiner states that:

Examiner requires copy of any non-patent literature, published application, or patent (U.S. or foreign) that was used in the invention process, such as by designing around or providing a solution to accomplish an invention result and identification of what is being improved. Patents or printed publication information submission is required particularly for the claimed subject matter relating to the claimed features beginning with the recitations “means for delivering purchase incentives,” “means for delivering e-mail notices,” “transmitting incentives via an e-mail post office,” “transmitting consumers a notice,” “means for informing the consumer of new incentives,” and “formatting an e-mail message for subsequent coupon printing.” [Office Action mailed 1/21/03 page 3 line 24 through page 4 line 2.]

The examiner requested prior art papers used in preparing this application. In reply, the undersigned inquired with (1) Catalina Law Department (for the Assignee), (2) Mike Scroggie (the first named inventor), and (3) Noel Heal (the attorney who drafted the application). All of those entities reported to the applicants that they had no readily available files relating to this request, and none of them recall any prior document used in preparing the application. The undersigned personally knows of no prior art used in preparing this application.

4. Item 4

In item 4, the examiner quotes 35 USC 101.

5. Item 5 - 35 USC 101 Rejection of Claim 58

In item 5, the examiner rejects claim 58 under 35 USC 101. The examiner states that:

Claim 58 is rejected under 35 U.S.C. 101 because the claimed method does not recite a useful, concrete and tangible result under *In re Alappat*, 31 USPQ2d 1545 (Fed. Cir. 1994) and *State Street Bank & Trust Co. v. Signature Financial Group Inc.*, 47 USPQ2d 1596 (Fed Cir. 1998). The independently claimed maintaining, generating, and formatting contain recitations of descriptive material that cannot exhibit any functional interrelationship with the way in which computing process are performed and does not constitute a statutory process, machine, manufacture or composition of matter under 35 U.S.C. 101. Also those steps can be performed mentally without interaction of any physical structure or

process. Because the independently claimed invention is directed to non-functional descriptive material which does not produce a useful, concrete and tangible result, those claims and claims depending from them, are not permitted under 35 U.S.C. 101 as being related to non-statutory subject matter. However in order to consider those claims in light of the prior art, examiner will assume that those claims recite statutorily permitted subject matter. [Office Action mailed 1/21/03 page 4 lines 8 - 20.]

In response, the applicants respectfully traverse this rejection because a database, as disclosed in this application, can not be accessed without a computer, an e-mail message can not be sent to a consumer without a computer, and generating an incentive in electronic form cannot be a mental step. Therefore, the claimed subject matter falls within the statutory subject matter defined by 35 USC 101. Therefore, the rejection under 35 USC 101 should be withdrawn.

Moreover, claim 58 is amended to recite delivering the information to the consumer. Delivering the incentive has real world utility as a matter of fact.

6. Item 6

In item 6, the examiner quotes the first paragraph of 35 USC 112.

7. Item 7 - 35 USC 112 First Paragraph Rejections of Claims 32-58

In item 7, the examiner rejects claims 32-58 under the first paragraph of 35 USC 112.

The examiner states that:

Claims 32-58 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. The independently claimed steps of a system and method of a web site for providing purchasing incentives from multiple sources; a consumer purchase history database based on consumer online shopping activity; a consumer database which can identify consumers by their e-mail addresses, wherein the consumer database is connected to the web site so as to receive consumer data from the web site are not enabled from the specification, because the specification does not discuss these system and method features such that one skilled in the art would be reasonably conveyed of inventor possession of the claimed invention. The specification merely recites vague language and general concepts but not the claimed details by the applicants. Since claims 33-37, 39-40, 45-49, 51-53, and 55-56 depend upon claim[s] 32, 38, 44, 50, and 54 which recite the independently claimed non-enabling new matter features, those claims are also rejected as being non-enabling new matter from the independent parent claim. In order to consider those claims in light of the prior art, examiner will assume that those claims

contain enabling subject matter. [Office Action mailed 1/21/03 page 5 line 8 through page 6 line 2.]

In reply, the applicants submit that these rejections are improper and should be withdrawn because there is no factual basis supporting the legal conclusion that any one of claims 32-58 violate the first paragraph of 35 USC 112.

The examiner's reasoning confuses enablement and written description requirements, so the applicant addresses both issues below.

a. Claims 32-58 are Enabled

The enablement rejections of claims 32-58 are improper for two reasons. First, the examiner has provided no facts or reasoning supporting a conclusion that programming of web sites was not within the level of skill of one of ordinary skill in the art as of the middle of the 1990s. Second, the subject matter of the invention relates to programming of web sites. Web site computer programming in particular and computer programming in general were well known in the early 1990s. It has long been the law that mere implementation in computer code of specified functions is within the skill of one of ordinary skill in the art. Since claims 32-58 specify functions implemented in computer code, these claims were enabled. Accordingly, the rejections of claims 32-58 are improper and should be withdrawn.

b. Claims 32-58 are Described in the Specification

i. Support for "a web site for providing purchasing incentives from multiple sources"

There is written description support for the independent claim limitation "a web site for providing purchasing incentives from multiple sources" on page 12 lines 11-17 of the specification. Page 12 lines 11-17 of the specification states that:

An alternative arrangement for distributing purchasing incentives over the Internet is illustrated in FIG. 13. This figure shows an incentive distribution server computer 300 and a user's personal computer 302 connected together through a computer network, indicated by the network cloud 304. The server 300 has an associated storage device 306 on which are stored multiple advertisements and promotions. The system as described thus far operates in much the same way as the system described above with reference to FIGS. 1-11. A user 308 logs on to the server 300 through the network 304 and selects from a variety of offers stored on the storage device 306 by *manufacturers and retailers*.

Specifically, the language “A user . . . selects from a variety of offers stored on the storage device 306 by *manufacturers and retailers*” supports the claimed language “purchasing incentives from multiple sources.”

ii. **Support for “a consumer purchase history database based on online shopping activity”**

a. **Page 23 lines 6-16**

There is written description support for the independent claim limitation “a consumer purchase history database based on consumer online shopping activity” on page 23 lines 6-16. Page 23 lines 6-16 of the specification states that:

The consumer purchase history 502 . . . is generated and updated from various sources pertaining to the shopping activities of all identifiable consumers. In-store loyalty programs based on past purchasing activity are one source of such data. *Any online shopping activity is another source.* Data from the consumer purchase history database 502 and from a database 622 of available incentives are joined together and used to generate incentives to be displayed on each consumer’s personal page. The personal page contents are updated, as indicated in block 624, the personal database 606 is updated to reflect these changes, and the consumer is notified by E-mail, as indicated in block 626, that the personal page has been updated. The Consumer can then go to the personal page and view the updated personal page.

Specifically, the language “*Any online shopping activity is another source*” gives support for the claimed language “a consumer purchase history database based on consumer online shopping activity.”

b. **Page 22 lines 10-17**

There is additional written description support for the independent claim limitation “a consumer purchase history database based on consumer online shopping activity” on page 22 lines 10-17. Page 22 lines 10-17 of the specification states that:

[T]he system sets up a personal page for the consumer, as indicated in block 604, and establishes a personal database 606, also for the individual consumer. The personal page displays a screen of information that is consumer-specific in many respects but will, of course, contain some data that is supplied to all consumers who have personal pages. The page is preferably personalized with the consumer’s name and may also contain the shopping list, if any, *already generated by the consumer in the current online session.* Significantly, the personal page will also contain offers and incentives targeted to the specific

consumer. . . .

Specifically, the language “*already generated by the consumer in the current online session*” gives support for the claimed language “a consumer purchase history database based on consumer online shopping activity.”

c. Page 20 line 25 - page 21 line 1

Moreover, there is additional written description support for the independent claim limitation “a consumer purchase history database based on consumer online shopping activity” on page 20 line 25 - page 21 line 1. Page 20 line 25 - page 21 line 1 of the specification states that:

Targeted purchase incentives are generated from the consumer purchase history database 502, as indicated in block 504. The system administrator also maintains a consumer database 506, which identifies consumers by their Email addresses. Alternatively, the consumer database 506 may be *integrated* with the consumer purchase history database 502. The consumer database 506 receives data primarily from the system administrator’s Web site, indicated at block 508, which, in turn, receives a consumer’s E-mail address from each consumer’s computer, indicated at 510.

Specifically, the language “the consumer database 506 may be *integrated* with the consumer purchase history database 502” and “The consumer database 506 receives data primarily from the system administrator’s Web site, indicated at block 508, which, in turn, receives a consumer’s E-mail address from each consumer’s computer, indicated at 510” gives support for the claimed language “a consumer purchase history database based on consumer online shopping activity.”

The word “integrated” means “denoting a works which combines various processes normally carried out at different locations.”¹ This act of combining the data between the two databases would allow both the consumer purchase history database and the consumer online shopping history database to share data. As shown in FIG. 15 of the specification, information from a consumer’s computer 510, for example the consumer’s email address that is retained, is transmitted to the consumer database 506 via the system administrator’s online Web site 508.

¹A printout of the definition of “integrated” at <http://www.foreignword.com/Tools/dictsrch.htm> is attachment 10.

The existence in the of a consumer's E-mail address is an indication of online shopping activity since a consumer must register with a valid E-mail address before generating a final list. Specification page 14 lines 25-27. Since the consumer database shares data with the consumer purchase history database 502, data in the consumer purchase history database is based on consumer online shopping activity.

iii. **Support for "a consumer purchase history database based on online shopping activity"**

a. **Page 15 lines 4-10**

There is written description support for the independent claim limitation "a consumer database which can identify consumers by their e-mail addresses" on page 15 lines 4-10. Page 15 lines 4-10 of the specification states that:

During the registration process, the customer's E-mail address is verified for correct syntax, as shown in block 90. The first time the customer registers, the E-mail address is used to create a unique household identification (id.), as shown in blocks 230 and 232. Subsequently, the user's household id. is used to reference prior registration information. The next steps are to record or update the consumer information, as indicated in block 234, and to proceed to final list generation, as indicated in block 236.

b. **Page 20 lines 26-27**

There is also written description support for the independent claim limitation "a consumer database which can identify consumers by their e-mail addresses" on page 20 lines 26-27. Page 20 lines 26-27 of the specification states that:

The system administrator also maintains a consumer database 506, which identifies consumers by their E-mail addresses.

c. **Page 20 line 29 - page 21 line 3**

There is also written description support for the independent claim limitation "a consumer database which can identify consumers by their e-mail addresses" on page 20 line 29 - page 21 line 3. Page 20 line 29 - page 21 line 3 of the specification states that:

The consumer database 506 receives data primarily from the system administrator's Web site, indicated at block 508, which, in turn, receives a consumer's E-mail address from each consumer's computer, indicated at 510. The consumer database 506 may also receive E-mail addresses from independent consumer E-mail address lists, indicated in block 512.

Specifically, at log-in, the first time the customer registers, a unique household identification is created from the customer's email address. In addition to the household identification, the E-mail address is captured by the system administrator's Web site, which receives the E-mail address from each customer's computer (510), as recited on page 20 line 29 - page 21 line 1 of the specification; and the E-mail address is retained in the consumer database (506), as recited on page 20 lines 26-7 of the specification. The E-mail address is further enhanced by the E-mail address information from the independent consumer E-mail address lists (512).

iv. **Support for "wherein the consumer database is connected to the web site so as to receive consumer data from the web site"**

There is written description support for the independent claim limitation "wherein the consumer database is connected to the web site so as to receive consumer data from the web site" on page 20 line 29 - page 21 line 1. Page 20 line 29 - page 21 line 1 of the specification states that:

The consumer database 506 receives data primarily from the system administrator's Web site, indicated at block 508, which, in turn, receives a consumer's E-mail address from each consumer's computer, indicated at 510.

This passage specifically provides support for the independent claim limitation "wherein the consumer database is connected to the web site so as to receive consumer data from the web site."

v. **Support for "means for delivering purchasing incentives to consumers by e-mail"**

There is written description support for the independent claim limitation "means for delivering purchasing incentives to consumers by e-mail" on page 20 lines 17-19. Page 20 lines 17-19 of the specification states that:

As shown in FIG. 15, the system of the invention also has the capability to deliver targeted or untargeted incentives to customers through their online E-mail address on the Internet or another computer network.

This passage specifically provides support for the independent claim limitation "means for delivering purchasing incentives to consumers by e-mail."

8. **Item 8**

In item 8, the examiner quotes the second paragraph of 35 USC 112.

9. **Item 9 - 35 USC 112 Second Paragraph Rejections of Claims 32-58**

In item 9, the examiner rejects claims 32-58 under the second paragraph of 35 USC 112.

The examiner states that:

Claims 32-58 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The independently claimed steps of a system and method of a web site for providing purchasing incentives from multiple sources; a consumer purchase history database based on consumer online shopping activity; a consumer database which can identify consumers by their e-mail addresses, wherein the consumer database is connected to the web site so as to receive consumer data from the web site fail to particularly point out and distinctly claim the subject matter which applicant regards as the invention, because the specification does not provide an antecedent basis for those features. Since the specification does not provide an antecedent basis for these critical independently claimed steps, the independently claimed invention is not described in the specification such that it fails to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Since claims 33-37, 39-40, 45-49, 51-53, and 55-56 depend on claim[s] 32, 38, 44, 50, and 54 which recite the independently claimed indefinite feature, those claims are also rejected as being indefinite from the independent parent claim. In order to consider those claims in light of the prior art, examiner will assume that those claims contain non-indefinite subject matter. [Office Action mailed 1/21/03 page 6 line 6 through page 7 line 2.]

In reply, the applicants disagree. First, the claim recitations are clear on their face, even without any reference to the specification. Therefore, their rejection is improper. Second, there is almost ipsius verbis antecedent basis support for the subject claim recitations in the specification, and the subject recitations are supported. See page 12 lines 11-17, page 15 lines 4-10, page 20 lines 17-19, and page 20 line 25 - page 21 line 3. Therefore, the rejections are improper.

Third, the second paragraph of 35 USC 112 is directed to the claims, not to the specification. Therefore, the examiner's assertion that "Since the specification does not provide an antecedent basis for these critical independently claimed steps, the independently claimed invention is not described in the specification such that it fails to particularly point out and distinctly claim the subject matter which applicant regards as the invention" is not a basis to

reject the claims under the second paragraph of 35 USC 112. Therefore, there is no factual assertion supporting the indefiniteness rejections. In summary, the rejections are improper and should be withdrawn.

10. Item 10

In item 10, the examiner quotes the sixth paragraph of 35 USC 112.

11. Item 11 - 35 USC 112 Sixth Paragraph Rejections of Claims 32, 33, 38, 39, 44, 45, and 57

In item 11, the examiner rejects claims 32, 33, 38, 39, 44, 45, and 57 under the sixth paragraph of 35 USC 112. The examiner states that:

Claims 32, 33, 38, 39, 44, 45, and 57 are rejected under 35 U.S.C. 112, sixth paragraph, as not setting a limit on how broadly the Office may construe means-plus-function language under the rubric of reasonable interpretation (please see MPEP 2181). Those claims contain means for language which is not construed means-plus-function language under the rubric of reasonable interpretation, because the specification does not provide a clear limit of patentability. Those claimed means are merely exemplified after the “for” recitation and may incorporate any function that could be taught in the prior art. In order to consider that claim in light of the prior art, examiner will assume that those claims contain a clear limitation under the broadest reasonable interpretation. [Office Action mailed 1/21/03 page 7 lines 8 - 16.]

In response the applicants respectfully traverse these rejections because they are improper.

First, 35 USC 112, sixth paragraph does not define a requirement with which the applicant must comply. Therefore, it is not a section of the statute which can form the basis for a rejection.

Second, the means for sending email delivered by claims 32, 33, 38, 39, 44, 45, and 57 are well defined since the term “email” is well defined in the art. Therefore, claims 32, 33, 38, 39, 44, 45, and 57 are definite.

Third, generating and operating web pages are well defined phrases in the art. Therefore, claim 57 is definite. Therefore, however construed, these rejections are improper and should be withdrawn.

12. Item 12

In item 12, the examiner quotes sections (b) and (e) of 35 USC 102.

13. Item 13 - 35 USC 102(b) and (e) Rejections of Claims 32-58

In item 13, the examiner rejects claims 32-58 under 35 USC 102(b) and 35 USC 102(e).

The examiner states that:

Claims 32-58 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Goldhaber et al. (US 5,794,210), Manasse (US 5,802,497), Huberman (US 5,826,244), Jovicic et al. (US 5,855,007) or Day et al. (US 5,857,175) and are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Barnett et al. (US 6,321,208). [Office Action mailed 1/21/03 page 8 lines 15 - 18.]

In reply, the applicants respectfully traverse these rejections because they are legally improper and not supported by substantial evidence and reasoning.

a. 35 USC 102(b)

The following is a quotation of 35 USC 102(b):

A person shall be entitled to a patent unless the invention was patented or described in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Goldhaber et al. (US 5,794,210), Manasse (US 5,802,497), Huberman (US 5,826,244), Jovicic et al. (US 5,855,007), and Day et al. (US 5,857,175) were each published after December 26, 1995, which is after PCT application PCT/US96/20497, of which application no. 09/756,788 is a continuation in part, was filed. Therefore, the five patents are not 102(b) prior art. Therefore, rejection under 102(b) is improper and should be withdrawn.

b. 35 USC 102(e)

i. No Prima Facie Showing

The examiner made no showing why any of the references cited in item 13 of the office action disclose the inventions claimed. Therefore, the rejections are all improper and should be withdrawn.

Moreover, as shown below, none of these references anticipate any claim in this application. For these additional reasons, the rejections are improper and should be withdrawn.

ii. **Goldhaber et al. - Filed December 11, 1995**

The examiner has not shown how this reference discloses the subject matter defined by any claim. Therefore, the rejections are improper and should be withdrawn.

Moreover, Goldhaber et al. discloses a method for performing attention brokerage services, which is the business of brokering the attention of Internet users. That disclosure does not anticipate any of the claims 32-58. For example, Goldhaber et al. does not recite the use of email for either sending notices to consumers or delivering purchasing incentives to consumers, which is recited in the independent claims (32, 38, 44, 50, 54, 57, and 58). The only mention of email in Goldhaber et al. is as a password. Goldhaber et al. column 13 lines 11-18. For this additional reason, Goldhaber et al. does not in fact disclose any one of the independent claims.

All of the dependent claims in application number 09/756,788 depend from one of the independent claims and each dependent claim is not disclosed by Goldfarb et al. for at least that reason. Therefore, Goldhaber et al. does not anticipate any claim. Therefore, the rejections of claims 32-58 based upon Goldhaber et al. are improper and should be withdrawn.

iii. **Manasse - Filed July 10, 1995**

The examiner has not shown how this reference discloses the subject matter defined by any claim. Therefore, the rejections are improper and should be withdrawn.

Manasse discloses a method of conducting computerized commerce. That disclosure does not anticipate any of the claims 32-58. For example, Manasse does not recite the use of email for either sending notices to consumers or delivering purchasing incentives to consumers, which is recited in the independent claims (32, 38, 44, 50, 54, 57, and 58). The only mention of email in Manasse is in the context of compensation for the expense of moderating email. Manasse column 6 lines 19-23. For this additional reason, Manasse does not in fact disclose any one of the independent claims.

All of the dependent claims in application number 09/756,788 depend from one of the independent claims and each dependent claim is not disclosed by Manasse for at least that reason. Therefore, Manasse does not anticipate any claim. Therefore, the rejections of claims 32-58 based upon Manasse are improper and should be withdrawn.

iv. Huberman - Filed August 23, 1995

The examiner has not shown how this reference discloses the subject matter defined by any claim. Therefore, the rejections are improper and should be withdrawn.

Huberman discloses a system for providing a computerized brokered auction mechanism for delivering document services over a network. That disclosure does not anticipate any of the claims 32-58. For example, Huberman does not recite the use of email for either sending notices to consumers or delivering purchasing incentives to consumers, which is recited in the independent claims (32, 38, 44, 50, 54, 57, and 58). The only mention of email in Huberman is in the context of transmitting a document to be edited or otherwise processed. Huberman column 1 lines 14-22. For this additional reason, Huberman does not in fact disclose any one of the independent claims.

All of the dependent claims in application number 09/756,788 depend from one of the independent claims and each dependent claim is not disclosed by Huberman for at least that reason. Therefore, Huberman does not anticipate any claim. Therefore, the rejections of claims 32-58 based upon Huberman are improper and should be withdrawn.

v. Jovivic et al. - Filed November 15, 1995

The examiner has not shown how this reference discloses the subject matter defined by any claim. Therefore, the rejections are improper and should be withdrawn.

Jovivic et al. discloses an electronic coupon system for generating and redeeming unique product discount coupons over public computer networks such as the Internet. That disclosure does not anticipate any of the claims 32-58. For this additional reason, Jovivic et al. does not in fact disclose any one of the independent claims.

All of the dependent claims in application number 09/756,788 depend from one of the independent claims and each dependent claim is not disclosed by Jovivic et al. for at least that reason. Therefore, Jovivic et al. does not anticipate any claim. Therefore, the rejections of claims 32-58 based upon Jovivic et al. are improper and should be withdrawn.

vi. Day et al. - Filed August 11, 1995

The examiner has not shown how this reference discloses the subject matter defined by any claim. Therefore, the rejections are improper and should be withdrawn.

Day et al. discloses a system for presenting customized special offers to customers. That disclosure does not anticipate any of the claims 32-58. For example, Day et al. does not disclose the use of email for either sending notices to consumers or delivering purchasing incentives to consumers, which is recited in the independent claims (32, 38, 44, 50, 54, 57, and 58). There is no recitation of email in Day et al. For this additional reason, Day et al. does not in fact disclose any one of the independent claims.

All of the dependent claims in application number 09/756,788 depend from one of the independent claims and each dependent claim is not disclosed by Day et al. for at least that reason. Therefore, Day et al. does not anticipate any claim. Therefore, the rejections of claims 32-58 based upon Day et al. are improper and should be withdrawn.

vii. **Barnett et al. - Filed April 19, 1995**

The examiner has not shown how this reference discloses the subject matter defined by any claim. Therefore, the rejections are improper and should be withdrawn.

Barnett et al. discloses a method and for the electronic distribution of product redemption coupons to remote personal computers located at user's homes. That disclosure does not anticipate any of the claims 32-58. For example, Barnett et al. does not recite the use of email for either sending notices to consumers or delivering purchasing incentives to consumers, which is recited in the independent claims (32, 38, 44, 50, 54, 57, and 58). The only mention of email in Barnett et al. is in reference to an email address being the user's identification number. Barnett et al. column 13 lines 54-57. For this additional reason, Barnett et al. does not in fact disclose any one of the independent claims.

All of the dependent claims in application number 09/756,788 depend from one of the independent claims and each dependent claim is not disclosed by Barnett et al. for at least that reason. Therefore, Barnett et al. does not anticipate any claim. Therefore, the rejections of claims 32-58 based upon Barnett et al. are improper and should be withdrawn.

14. **Item 14**

In item 14, the examiner quotes 35 USC 103(a).

15. **Item 15**

In item 15, the examiner quotes the factual inquiries set forth in *Graham v. John Deere*

Co., 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 USC 103(a).

16. Item 16 - 35 USC 103(c) Rejection of Claims 32-58 Based Upon (1) Examiner's Alleged Personal Knowledge and (2) the www.PerformanceBike.com Web Site

In item 16, the examiner rejects claims 32-58 under 35 USC 103(a). The examiner states that:

Claims 32-58 are rejected under 35 U.S.C. 103(a) as being unpatentable over an obvious variation of examiner's personal knowledge of consumer purchasing incentive distribution provided by PerformanceBike.com (hereinafter PerformanceBike). Since at least 1994, PerformanceBike has performed the claimed method and system of:

- a web site for providing purchasing incentives from multiple sources;
- a consumer purchase history database based on consumer online shopping activating;

- a consumer database which can identify consumers by their addresses, wherein said consumer database is connected to said website so as to receive consumer data from said web site; and any one of

- means for delivering purchasing incentives or web site visit notices to consumers;

- means for delivering notices to purchase a specific manufacturer's product;

- transmitting purchase incentives or web site visit notices via a post office; and

- means for or a method informing of new incentives or printing coupons.

Examiner also has personal knowledge of consumer profile basis, purchase history database either by an independently administered or cooperative site, and where purchase history includes data based on past purchasing activity. The claimed web site for providing purchasing incentives from multiple sources occur when the examiner went into a PerformanceBike retail outlet store, web site or kiosk and viewed discounted products from a sales catalog. The claimed consumer purchase history database based on consumer online shopping activating occurs when the examiner became a member of Team Performance which is a frequent buyer program and submitted demographic data. The claimed consumer database which can identify consumers by their addresses, wherein said consumer database is connected to said website so as to receive consumer data from said web site occurs when examiner submitted data to associate the PerformanceBike web site to receiving shopping information. The claimed steps including means for delivering purchasing incentives or web site visit notices to customers, means for delivering notices to purchase a specific manufacturer's product, transmitting purchasing incentives or web site visit notices via a post office, and means for or a

method informing of new incentives or printing coupons were administered by Performance Bike through sale mailings which included coupons of products available either at the retail outlet or web site. The claimed invention, recited by the applicant, has been provided by PerformanceBike long before the filing of applicants' invention. Examiner takes Official notice that it is old and well known to those skilled in the art of distributing purchase incentives to consumers, that it would have been obvious to claim the invention as recited by the applicant, in order to overcome the explicit teachings of the published prior art. Furthermore examiner experience teaches the claimed invention except for the claimed e-mail notification. It would have been obvious to one skilled in the art to provide the claimed e-mail notification since e-mail is merely an automated feature of a concept that is old and well known as discussed above. Please see *In re Venner*, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958) in which the court held that broadly providing an automatic or mechanical means to replace a manual activity which accomplished the same result is not sufficient to distinguish over the prior art. The motivation to combine applicants claimed invention with the services offered by PerformanceBike in order is to allow advertisers greater consumer targeting capabilities through electronic mail mediums, while transferring electronic information, which clearly shows the obviousness of the claimed invention. [Office Action mailed 1/21/03 page 9 line 11 - page 11 line 13.]

In reply, the applicants respectfully traverse these rejections because they fail to carry the burdens of proof and persuasion, particularly in view of additional evidence submitted herewith.

The examiner alleges based upon personal knowledge the existence of the PerformanceBike.com web site of "[s]ince at least 1994." This allegation, even though asserted now by the examiner in a declaration, fails to carry the burden of proof as to the existence of the PerformanceBike.com web site prior to the applicant's priority filing date, i.e., prima facie date of invention of December 23, 1996.

a. No Physical Evidence Supports the Examiner's Decision

That applicant first points out that there is no physical evidence supporting the examiner's assertions. In fact, the PerformanceBike.com website printout enclosed with the July 29, 2002 office action shows a copyright year of 2000, which is the prima facie date associated with that website. Accordingly, no physical evidence supports the examiner's assertion that the PerformanceBike.com web site was prior art.

b. **Probative Evidence Exists That The PerformanceBike.com Web Site Did Not Exist In 1994**

Submitted with this response is probative physical evidence that the www.PerformanceBike.com web site did not exist until some time in 1997, and certainly no earlier than December of 1996.

i. **The Web Master for PerformanceBike.com Indicated That the First PerformanceBike.com Web Site Was Launched in Late 1996**

I spoke with the web master of performance bike on 9/19/02, via telephone. The web master is Andrew Ruggeri, telephone number 800-433-1633 (at an internal company extension of that number). Mr. Ruggeri clearly indicated to me (1) that he knew that the first web site for Performance Bike was launched in *August or September of 1996*, (2) that he became an employee of Performance Bike in 1997, and (3) that he knew that the Performance Bike web site has never provided coupons for retail store purchases. Mr. Ruggeri indicated that one reason the web site has never provided coupons for retail store purchases was that the pricing structure for web based sales and retail store sales were different, and therefore, placing incentives for retail store purchase on the website would be incompatible with the distinct pricing for web site sales and retail store sales.

I attempted to get a declaration from Mr. Andrew Ruggeri, but his company referred me to its outside IP counsel, Christopher Bolen, Esq., and Mr. Bolen refused my requests. Third party discovery is not available for ex parte matters, and therefore I do not have the right to compel a declaration at this time. Since this evidence is currently unavailable to me, I reserve the right to supplement this brief with that evidence, if and when it becomes available.

ii. **Physical Evidence Indicates That The PerformanceBike.com Web Site Came into Existence in Late 1997**

A ten-page printout at URL www.archive.org/about/about.php describing the

WAYBACK MACHINE is submitted herewith.² A five page printout of the URL www.archive.org is submitted herewith.³ A two page printout of the URL pages.alexa.com/company/index.html?p=Dest_W_t_40_B1 is submitted herewith.⁴ As indicated in those attachments, www.archive.org is run by the "Internet Archive", which is a non profit library organization dedicated to archiving the Internet. The Internet Archive has been receiving data regarding the web from "Alexa", which is a company that runs a 'web crawler.' A web crawler is a system that downloads and reviews all of the high level URLs for content on a periodic basis, for indexing their content for use by search engines.

The WAYBACK MACHINE is a web enabled interface between the Internet Archive's data store that enables anyone with a web browser to see what web sites looked like on prior dates. See attachment 2.

Moreover, the Director has instructed the examiners to rely upon the Wayback Machine to prove web site prior art dates. The USPTO hosted a "Business Methods Partnership Meeting" on April 1, 2003, which was open to the public. At this meeting, Jim Trammell, Supervisory Patent Examiner, TC 3600, and Bob Weinhardt, Quality Assurance Specialist, TC 3600, made the presentation "When is an Electronic Document a Printed Publication for Prior Art Purposes?"⁵ The presenters in particular identified the "Wayback Machine" as among the "Resources Used by Examiners to Establish Website Dates."⁶ The presenters stated that the Wayback Machine "[f]inds archived web pages back to 1996."⁷ The presenters made it quite

²A copy of the ten page printout of www.archive.org/about/about.php is attachment 1.

³A copy of the five page printout of www.archive.org is attachment 2.

⁴A copy of the two page printout of pages.alexa.com/company/index.html?p=Dest_W_t_40_B1 is attachment 3.

⁵A Copy of the presentation "When is an Electronic Document a Printed Publication for Prior Art Purposes?" is attachment 12. This presentation was made as part of the USPTO's "Business Methods Partnership Meeting" with the public, held April 1, 2003.

⁶Slide 25 from Attachment 12.

⁷Slides 27-29 from Attachment 12.

clear that the USPTO's examiners are relying on Wayback Machine archive dates as evidence showing prior art dates for websites. Thus, the applicants use of the Wayback Machine herein should be accorded equal respect.

I used the WAYBACK MACHINE to see which versions of the PerformanceBike.com web site existed at prior dates. Specifically, I used the WAYBACK MACHINE's search function for <http://performancebike.com> November 27, 2002. My results are attachment 4.⁸ The search result shows that PerformanceBike.com web site was not launched until October 1997. Specifically, attachment 4 states "0 pages" under the heading 1996, which strongly suggests that, although the URL domain name was registered with the domain name register in 1996, no web pages were associated with the logical address www.PerformanceBike.com that could be downloaded to a user's computer via use of a web browser until after 1996. In contrast, attachment 4 shows web pages associated with www.PerformanceBike.com beginning October 17, 1997, and web pages continuously associated with that URL ever since. This evidence implies that the www.PerformanceBike.com web site, that is, a URL which would transmit web pages to a user, did not exist prior to the priority filing date for this application.

I attempted to get a declaration from a representative of the Internet Archive. However, their representative referred me to their counsel, which is Rachel Silvers of the firm of Perkins Coie LLP in San Francisco. Ms. Silvers indicated that the Internet Archive refused to provide a declaration explaining the meaning of the "1996 0 pages" text in attachment 4. Third party discovery is not available for ex parte matters, and therefore I do not have the right to compel a declaration at this time. Since this evidence is currently unavailable to me, I reserve the right to supplement this brief with that evidence, if and when it becomes available.

iii. **The www.PerformanceBike.com Domain Name Was Not Even Registered Until December 3, 1996**

Network Solutions, Inc. was founded in 1979 and is located in Herndon, Virginia. Until recently, in 1999, Network Solutions, Inc. was the only registrar of domain names for the web.

⁸A copy of the printout of the WAYBACK MACHINE'S search result for <http://performancebike.com> conducted on November 27, 2002 is attachment 4.

www.netsol.com is Network Solutions, Inc.'s web site.⁹ It contains a WHOIS search engine.

This type of search engine provides users information related to a particular web site, such as registrant name, date of initial registration, and date of most recent update.

I conducted a search for www.PerformanceBike.com on the WHOIS search engine at www.netsol.com on December 2, 2002. A printout of the WHOIS search result for www.PerformanceBike.com from www.netsol.com WHOIS search engine is submitted herewith as attachment 7.¹⁰ The search result shows that the domain name www.PerformanceBike.com was not registered December 3, 1996.

When a domain name is registered, it is by contract, controlled by the entity that purchased it. It does not automatically have web pages, i.e., a web site, associated with it. Therefore, the mere fact that www.PerformanceBike.com was registered on December 6, 1996, does not imply that a web site, i.e., content available for downloading to a user's browser, existed on that date. In fact, complicated web sites often take months to develop before they are ready for loading onto the web as a web site.

I attempted to get a declaration from a representative of NSI explaining that the date listed in their WHOIS search engine is the date that a domain name was first registered in the master Domain Name Service hosted by NSI and therefore the earliest date on which the domain name would have been available for hosting a web site.

A representative of NSI verbally indicated to me that NSI only accepted subpoenas for testimony via FAX, and that NSI did not respond to voluntary requests for discovery. Third party discovery is not available for ex parte matters, and therefore I do not have the right to compel a declaration at this time. Since this evidence is currently unavailable to me, I reserve the right to supplement this appeal with that evidence, if and when it becomes available.

⁹A copy of the two page printout from www.verisign.com/corporate/news/apr_19980107.html describing Network Solutions, Inc., is attachment 5. A copy of the two page www.wired.com/news/politics/0,1238,31551,00.html is attachment 6.

¹⁰A copy of the two page printout from www.netsol.com's WHOIS search engine for www.PerformanceBike.com is attachment 7.

c. **The Weight of the Evidence is that the PerformanceBike Web Site did not Exist in 1994**

All of the above listed physical evidence is contradictory to the assertions provided in the examiner's declaration as to the date of existence of the PerformanceBike.com web site, and to the assertion that the web site is legal prior art.¹¹ The APJs must compare the weight of the physical evidence indicating that the web site did not exist until 1997 to the examiner's recollection that the web site existed in 1994. I submit that the examiner's unsupported recollection is clearly outweighed by the weight of the physical evidence and the information Mr. Ruggieri passed along to me.

d. **Objectively Implausible Nature of Factual Assertions in the Examiner's Declaration**

The examiner made blanket statements in his declaration that each and every limitation claimed in claims 32-58 were known to him prior to December 1996. In fact, the examiner has made the same type of blanket statement in rejecting all claims in attorney docket CAT/29US-SCROCO, application number 09/401,939, which is also now on appeal. The examiner's allegations that so many limitations in so many claims were personally known to him are objectively implausible. For this reason, the examiner's declaration should be given little or no probative weight.

e. **The PerformanceBike.com Web Site Did Not In Fact Anticipate or Suggest Any One of Claims 32-58**

The applicants point out that the PerformanceBike.com web site does not now and did not in 1997, distribute incentives for in-store use, contrary to the examiner's assertion. A copy of printouts of pages of the PerformanceBike web site obtained from the WAYBACK MACHINE's archive of the www.performancebike.com web site is attachment 8. That archive shows a web site which has none of the functionality defined in the pending claims. None of those pages disclose or appear to provide incentives for in store use.¹² Accordingly, to the extent the

¹¹ A copy of the 3 page examiner affidavit supporting obviousness rejection from Application no. 09/401,939 office action mailed November 22, 2002 is attachment 9.

¹² A copy of the printout of 8 pages of the PerformanceBike.com web site from 1997, as stored in the WAYBACK MACHINE is attachment 8.

examiner relies upon his memory for recollection of web site based incentives, the rejections of claims 32-58 are improper and should be withdrawn.

For all the foregoing reasons, the rejections based upon the examiner's declaration are improper and should be withdrawn.

The examiner corresponds claimed limitations to non-web site structure appearing in a retail store or a kiosk, or viewing discounted products residing in the retail outlet store.

Furthermore, the examiner asserts that:

The claimed web site for providing purchasing incentives from multiple sources occur when the examiner went into a PerformanceBike retail outlet store, web site or kiosk and viewed discounted products from a sales catalog. [Office Action mailed 1/21/03 page 10 lines 6 - 8.]

In reply, the applicants disagree because the examiner's reliance upon the Performancebike.com web site as suggesting the claimed invention is logically improper.

There are no features claimed related to going into a retail store or a kiosk or viewing discounted products from a sales catalog. Thus, the examiner's rejection is irrelevant to the present invention and should be withdrawn.

f. Obviousness Rejections Based on the Examiner's Declaration

The examiner asserts that:

Furthermore examiner experience teaches the claimed invention except for the claimed e-mail notification. It would have been obvious to one skilled in the art to provide the claimed e-mail notification since e-mail is merely an automated feature of a concept that is old and well known as discussed above. [Office Action mailed 1/21/03 page 11 lines 4 - 7.]

In reply, the applicants disagree because the mere fact that the prior art that the examiner declared he "experienced" via PerformanceBike.com could be modified would not have made the modification obvious, absent some teaching in the prior art motivating the modification of the prior art. In re Deminski, 796 F.2d 436, 230 USPQ 3113 (Fed. Cir. 1986).

Moreover, the web site provides no teaching suggesting incentives distributed over the Internet. Therefore, the rejections relying upon the examiner's experience of the PerformanceBike.com web site are improper and should be withdrawn.

g. Rejections Based on Official Notice

The examiner notes that:

Examiner takes Official notice that it is old and well known to those skilled in the art of distributing purchase incentives to consumers, that it would have been obvious to claim the invention as recited by the applicant, in order to overcome the explicit teachings of the published prior art. [Office Action mailed 1/21/03 page 11 lines 1 - 4.]

In reply, applicants first submit that the examiner's reliance on official notice is improper, since it forms the basis for the examiner's obviousness conclusion. See Barry, "Did You Ever Notice? Official Notice in Rejections" 81 JPTOS 129 (1999).¹³ Second, the foregoing quotation contains no reasoning. Accordingly, the rejections relying upon the official notice are improper and should be withdrawn.

17. Item 17

In item 17, the examiner quotes grounds for a nonstatutory double patenting rejection.

18. Item 18 - Obviousness-type Double Patenting Rejections Over Claims of USPs 5,790,649, 6,014,634, and 6,185,541

In item 18, the examiner rejects claims 32-58 under the judicially created doctrine of obvious-type double patenting. The examiner states that:

Claims 32-58 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-3 of U.S. Patent No. 5,970,469 or claims 1-39 of U.S. Patent No. 6,014,634 or claims 1-10 of U.S. Patent No. 6,185,541. Although the conflicting claims are not identical, they are not patentably distinct from each other because the patented claim transmitting/receiving customer information over a network ('469 patent) is an obvious variation of the application claimed e-mail, because the patented claim personal information transmission data over a network ('634 patent) is an obvious variation of the application claimed e-mail, and because the patented claim of transmitting e-mail purchase incentive because in all three cases, both perform the same function in the same manner with the same result. [Office Action mailed 1/21/03 page 12 lines 9 - 17.]

¹³ A copy of Barry, "Did You Ever Notice? Official Notice in Rejections" 81 JPTOS 129 (1999) is attachment 11.

a. The Double Patenting Rejections Over Claims 1-3 of U.S. Patent No. 5,970,469

In reply, the applicants traverse the rejections. The examiner has not made a prima facie case and there is no substantial evidence supporting the examiner's rejections.

First, the examiner has not made a limitation by limitation comparison to show why claims 32-58 would have been obvious in view of any claim in USP 5,970,469. Therefore, the rejections are improper.

Second, the claims in Patent No. 5,970,469 are directed to a method and system for distributing purchasing incentives to retail customers including the steps of: transmitting a list of recipes to the customer, receiving customer selection of one or more recipes, transmitting back to the customer a shopping list that includes ingredients needed for each recipe and transmitting to the customer at least one purchase incentive pertaining to an ingredient product used in a selected recipe.

In contrast, the claims in the pending application are directed to a method and system consisting of a Web site for providing purchasing incentives from multiple sources, a consumer purchase history database based on consumer online shopping activity, and means for delivering purchasing incentives to consumers by e-mail. Since the claims in the pending application are not directed towards the same invention as those in patent No. 5,970,469, the double patenting rejections are improper and should be withdrawn.

b. The Double Patenting Rejections Over Claims 1-39 of U.S. Patent No. 6,014, 634

In reply, the applicants traverse the rejections. The examiner has not made a prima facie case and there is no substantial evidence supporting the examiner's rejections.

First, the examiner has not made a limitation by limitation comparison to show why claims 32-58 would have been obvious in view of any claim in USP 5,970,469. Therefore, the rejections are improper.

Second, the claims in 6,014,634 are directed to a computer implemented method for determining purchasing incentives for consumers including the steps of generating page data defining a personal web page.

In contrast, the claims in the pending application are directed to a method and system

consisting of a Web site for providing purchasing incentives from multiple sources, a consumer purchase history database based on consumer online shopping activity, and means for delivering purchasing incentives to consumers by e-mail. Since the claims in the pending application are not directed towards the same invention as those in patent No. 6,014,634, the double patenting rejections are improper and should be withdrawn.

c. **The Double Patenting Rejections Over Claims 1-10 of U.S. Patent No. 6,185,541**

In reply, the applicants traverse the rejections. The examiner has not made a prima facie case and there is no substantial evidence supporting the examiner's rejections.

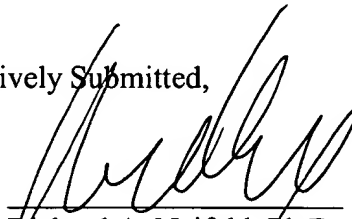
First, the examiner has not made a limitation by limitation comparison to show why claims 32-58 would have been obvious in view of any claim in USP 5,970,469. Therefore, the rejections are improper.

Second, the claims in Patent No. 6,185,541 are directed to a method and system for receiving the user's personal identity and region data and transmitting a selected region purchase incentive offer to the user, wherein the incentive offer contains very detailed image elements.

In contrast, the claims in the pending application are directed to a method and system consisting of a Web site for providing purchasing incentives from multiple sources, a consumer purchase history database based on consumer online shopping activity, and means for delivering purchasing incentives to consumers by e-mail. Since the claims in the pending application are not directed towards the same invention as those in patent No. 6,185,541, the double patenting rejections are improper and should be withdrawn.

Respectively Submitted,

4/17/03
Date


Richard A. Neifeld, Ph.D.
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Attorney of Record



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PATENT TRADEMARK OFFICE

Printed: April 17, 2003 (9:30am)
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D. Appendix I - Marked-up Copy of Claims Pending

32. A system for delivering incentives over the Internet comprising:
a Web site for providing purchasing incentives from multiple sources;
a consumer purchase history database based on consumer online shopping activity;
a consumer database which can identify consumers by their e-mail addresses, wherein
said consumer database is connected to said Web site so as to receive consumer data from said
Web site; and

means for delivering purchasing incentives to consumers by e-mail.

33. The system of claim 32 wherein said means for delivering purchase incentives
delivers purchasing incentives based on consumer profile.

34. The system of claim 32 wherein the consumer purchase history database and
said consumer database are integrated.

35. The system of claim 32 wherein said Web site is an independently administered
Web site.

36. The system of claim 32 wherein said Web site is a cooperative site.

37. The system of claim 32 wherein said consumer purchase history database
includes data based on past purchasing activity.

38. A system for delivering incentives over the Internet comprising:
a Web site for providing purchasing incentives from multiple sources;
a consumer purchase history database based on consumer online shopping activity;
a consumer database which can identify consumers by their e-mail addresses, wherein
said consumer database is connected to said Web site so as to receive consumer data from said
Web site; and

a means for delivering by e-mail notices which remind consumers to visit said Web site.

39. The system of claim 38 wherein said means for delivering e-mail notices
delivers notices based on consumer profile.

40. The system of claim 38 wherein the consumer purchase history database and
said consumer database are integrated.

41. The system of claim 38 wherein said Web site is an independently administered

Web site.

42. The system of claim 38 wherein said Web site is a cooperative Web site.

43. The system of claim 38 wherein said consumer purchase history includes data based on past purchasing activity.

44. A system for delivering incentives over the Internet comprising:
a Web site for providing purchasing incentives from multiple sources;
a consumer purchase history database based on consumer online shopping activity;
a consumer database which can identify consumers by their e-mail addresses, wherein said consumer database is connected to said Web site so as to receive consumer data from said Web site; and

means for delivering by e-mail notices to purchase a specific manufacturer's product.

45. The system of claim 44 wherein said means for delivering e-mail notices delivers notices based on consumer profile.

46. The system of claim 44 wherein the consumer purchase history database and the consumer database are integrated.

47. The system of claim 44 wherein said Web site is and independently administered Web site.

48. The system of claim 44 wherein said Web site is a cooperative Web site.

49. The system of claim 44 wherein said consumer purchase history database includes data based on past purchasing activity.

50. A method for delivering purchasing incentives over the Internet comprising the steps of:

providing a Web site which offers shopping incentives from multiple sources;
maintaining a consumer purchase history database based on consumer online shopping activity;

receiving a consumer's e-mail address from a consumer's computer;
maintaining a consumer email database which can identify consumers by their e-mail address; and

transmitting purchase incentives via an e-mail post office.

51. The method of claim 50 wherein the step of transmitting purchase incentives to the consumer by electronic mail includes transmitting purchase incentives based on a consumer profile.

52. The method of claim 50 wherein the step of providing a Web site is performed by an independent Web site administrator.

53. The method of claim 50 wherein the step of providing a Web site is achieved cooperatively.

54. A method for delivering incentives over the Internet comprising the steps of:
providing a Web site which offers purchasing incentives from multiple sources;
maintaining a consumer purchase history database based on consumer online shopping activity;
receiving a consumer's e-mail address from a consumer's computer;
maintaining a consumer database which can identify consumers by their e-mail address;
and
transmitting to consumers a notice to visit the Web site via the consumer's e-mail post office.

55. The method of claim 54 wherein the step of providing a Web site is performed by an independent Web site administrator.

56. The method of claim 54 wherein the step of providing a Web site is achieved cooperatively.

57. A Web site for providing information and shopping incentives from multiple sources such as retailers and manufacturers comprising:
a personal database;
a purchase history database wherein the data on the consumer purchases are based on X
online shopping activity;
means for generating a web page with a consumer-specific display;
means for updating said web page; and
means for informing the consumer by e-mail of new incentives.

58. (Amended) A method for delivery of incentives by e-mail, comprising the steps of:

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cont'd

maintaining a consumer database which identifies consumers by their e-mail addresses;
generating targeted purchase incentives from a consumer purchase history database; and
formatting an e-mail message to a consumer by electronic mail for subsequent printing
of a coupon[.]; and

delivering the email message to an email address stored in said consumer database for
said consumer.

59. (New) The system of claim 32 wherein said online shopping activity stored in said
consumer purchase history database comprises shopping list selections data.

60. (New) The system of claim 32 wherein said online shopping activity stored in said
consumer purchase history database comprises rebate offers data.

61. (New) The system of claim 32 wherein said online shopping activity stored in said
consumer purchase history database comprises notices detailing specific offers data.

62. (New) The system of claim 32 wherein said online shopping activity stored in said
consumer purchase history database comprises focused incentives based on a consumer's prior
shopping activity data.

b2

63. (New) The system of claim 32 wherein said online shopping activity stored in said
consumer purchase history database comprises purchasing incentives for data defining coupons
for subsequent printing by a consumer.

64. (New) The system of claim 32 wherein said online shopping activity stored in said
consumer purchase history database comprises links to at least one of manufacturer and retailer
web sites.

65. (New) The system of claim 32 wherein said online shopping activity stored in said
consumer purchase history database comprises data enabling a consumer to request at least one
of information regarding a product and a sample of said product.

66. (New) The system of claim 32 wherein said consumer purchase history database
stores data from any online shopping activity.

67. (New) The system of claim 32 wherein said consumer purchase history database
stores an administrator of said system's web site data.

68. (New) The system of claim 32 wherein said consumer purchase history database

stores retail store purchase data, including a consumer's favorite brands data.

69. (New) The system of claim 32 wherein said consumer purchase history database stores data including at least three of said customer identification number, name, residential address, zip code, and email address.

70. (New) The system of claim 32 wherein said consumer purchase history database stores selected consumer demographic information data, including at least two of number of persons in a household, age categories of persons in said household, and number of pets in said household.

71. (New) The system of claim 32 further comprising code for generating targeted, time phased incentives based on a consumer's actual buying patterns and preferences.

72. (New) The system of claim 32 further comprising code for generating untargeted incentives offered by manufacturers or retailers.

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Contd
73. (New) The system of claim 32 wherein said purchase incentives contain data enabling coupons to be printed by said consumer.

74. (New) The system of claim 32 wherein said purchase incentives contain data enabling purchase incentives to be printed at point of sale.

75. (New) The system of claim 32 further comprising means to encode in a consumer's identification card, tokens representing said purchase incentives.

76. (New) The method of claim 50 wherein said online shopping activity data stored in said consumer purchase history database comprises shopping list selections associated with a particular consumer.

77. (New) The method of claim 50 wherein said online shopping activity data stored in said consumer purchase history database comprises rebate offers data associated with a particular consumer.

78. (New) The method of claim 50 wherein said online shopping activity stored in said consumer purchase history database in association with an identification for a particular consumer comprises data detailing notice of specific offers provided to said particular consumer.

79. (New) The method of claim 50 further comprising generating focused incentives for

a consumer based on said consumer's prior shopping activity.

80. (New) The method of claim 50 further comprising generating purchasing incentives data in a form suitable for printing of a coupon by a consumer.

81. (New) The method of claim 50 further comprising generating links to at least one of manufacturer and retailer web sites and associating said links with a particular consumer.

82. (New) The method of claim 50 further comprising enabling a consumer to request at least one of information regarding a product and a sample of a product.

83. (New) The method of claim 50 wherein said consumer purchase history database stores data from an administrator of said system's web site.

84. (New) The method of claim 50 wherein said consumer purchase history database stores retail store purchase data, including a consumer's favorite brands.

85. (New) The method of claim 50 wherein said consumer purchase history database stores at least three of said customer identification number, name, residential address, zip code, and email address.

86. (New) The method of claim 50 wherein said consumer purchase history database stores selected consumer demographic information, including at least two of number of persons in a household, age categories of persons in said household, and number of pets in said household.

87. (New) The method of claim 50 wherein said purchase incentives include targeted, time phased incentives based on a consumer's actual buying patterns and preferences.

88. (New) The method of claim 50 wherein said purchase incentives include untargeted incentives from at least one of manufacturers and retailers.

89. (New) The method of claim 50 further comprising printing said purchase incentives on a printer connected to and controlled by a consumer's computer.

90. (New) The method of claim 50 further comprising printing purchase incentives at point of sale.

91. (New) The method of claim 50 further comprising encoding in a consumer's identification card tokens representing said purchase incentives.

E. Appendix II - List of Attachments

Attachment Number	Description of Attachment
1	A copy of the ten page printout of www.archive.org/about/about.php .
2	A copy of the five page printout of www.archive.org .
3	A copy of the two page printout of pages.alexa.com/company/index.html?p=Dest_W_t_40_B1 .
4	A copy of the printout of the WAYBACK MACHINE'S search result for http://performancebike.com conducted on November 27, 2002.
5	A copy of the printout from www.verisign.com/corporate/news/apr_19980107.html describing Network Solutions, Inc.
6	A copy of www.wired.com/news/politics/0,1238,31551,00.html .
7	A copy of the printout from www.netsol.com 's WHOIS search engine for www.PerformanceBike.com .
8	A copy of the printout of 8 pages of the PerformanceBike.com web site from 1997, as stored in the WAYBACK MACHINE.
9	A copy of the 3 page examiner affidavit supporting obviousness rejection from Application no. 09/401,939 office action mailed November 22, 2002.
10	A printout of the definition of "integrated" at http://www.foreignword.com/Tools/dictsrch.htm .
11	A copy of Barry, "Did You Ever Notice? Official Notice in Rejections" 81 JPTOS 129 (1999).
12	Trammell, Jim, Supervisory Patent Examiner TC 3600 and Weinhardt, Bob, Quality Assurance Specialist TC 3600, "When is an Electronic Document a Printed Publication for Prior Art Purposes?" presented at the USPTO's Business Methods Partnership Meeting, April 1, 2003, 32 pps.